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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,018	03/23/2004	Husnu M. Kalkanoglu	2003-116	2247

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PAUL AND PAUL  
2000 MARKET STREET  
SUITE 2900  
PHILADELPHIA, PA 19103

EXAMINER
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PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1792

NOTIFICATION DATE	DELIVERY MODE
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02/06/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

10/807,018

**Applicant(s)**

KALKANOGLU ET AL.

**Examiner**

Frederick J. Parker

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

#### *Rule 105 Request*

1. The Declaration of Robert L. Jenkins dated 12-17-07 satisfies the issues of this request, and he is thanked for providing a concise, definitive response to the request.

#### *Claim Rejections - 35 USC § 103*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-7,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koscitzky US 5664385.

Koscitzky teaches making roofing shingles by applying a hot hardenable asphalt/ adhesive onto a longitudinally moving base sheet and then applying adjacent areas of colored granules onto the surface of the sheet (col. 3, 3-43). As recognized on col. 4, there are **gradational overlapping color transition zones 36** between the (three) different colored areas 26 a-c, per claims 2,4,6, as shown in figure 2 and taught on col. 4, 27-42. Subsequently, slots 76 are formed in each of the transition intermediate areas 36 between colored areas where the two blend drops are intermixed in order to form a “sharp visual demarcation between adjacent colored areas” (emphasis added) (col. 5, 4-18), the intermediate areas 36 each having a width. (Note the goal of the reference is the same as that of Applicants, see page 2, 4<sup>th</sup> paragraph.) Col. 5, 34-38 notes the remaining region of the transition areas are not noticeable to the eye because of the slot. Figure 2 shows

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width differences between colored areas 26 a-c to provide varied aesthetics between colored areas.

Koscitzky teach removing overlapping transition zone, **preferably** (but not limited to) those areas containing about 50:50 of 2 adjacent blend drops, to provide a clear line of demarcation between adjacent colored areas (see col. 5, 17-19). Column 5, line 4+ states slots 76 are located in all or substantially all of the transition areas 36 between adjacent colored areas; further col. 7, 3-9 teach slots 76 may vary in width and appearance, and hence the sharpness of transition zones will vary depending on desired visual aesthetics. There is no evidence presented by Applicants that completely removing the intermediate across its width provides any mechanical or other advantage not cited by the reference. Thus it is the Examiner's position that the reference provides at least the suggestion for complete removal when conditions so necessitate, and further note there is no limitation against doing so. Modifying the teachings of Koscitzky for strictly decorative or aesthetic purposes does not patentably distinguish over the prior art but rather would have simply been an obvious modification. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431.

Summarizing Koscitzky, it carries out the same process as Applicants, preferably on the centered areas having an approximate 50:50 ratio of overlapping granules. Koscitzky is not limited to this scenario, nor is the reference limited as to width size (e.g. col. 7, 3-8). The goal is to provide a clear line of demarcation between adjacent colored areas and wherein transition is not visually noticeable (col. 5, 34-37). Thus, removal of more than just the most visible part of the overlapping region is merely an obvious modification because the result would predictably

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have been an even less chance of the overlapping region from being visually noticed, which is the main goal of the teachings of Koscitzky. The combination of familiar elements according to known methods is generally obvious when it does no more than yield predictable results, KSR, 127 Sup. Ct. at 1739, 2007. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Koscitzky by removing any or all of the width of the intermediate granule drop transition region as required by forming a slot to provide a desired ornamentation or aesthetic effect.

4. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koscitzky in view of the Admitted prior Art (APA), pages 1-2.

Koscitzky is cited for the same reasons previously discussed, which are incorporated herein. Applying second layers to make a laminated shingle is not cited.

The APA teaches it is known to form laminated shingles from two or more layers of shingle components. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Koscitzky by forming multi-layer laminated shingles as the shingle type as disclosed by the APA prior to slotting intermediate areas to form laminated shingles with sharp visual demarcations between adjacent colored areas.

#### ***Response to Arguments***

Applicant's remarks regarding the 35 USC 103 rejection have been considered.

Page 3 last 2 paragraphs of Remarks takes issue with the Examiner's previous conclusion the goal of Applicants and Koschitzky are not the same. As previously established, Koschitzky cuts slots to remove portions of overlap granules preventing a sharp visual line of demarcation which

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is deemed “highly undesirable” (col. 4, 35-42) and “preferably they (the slots) remove the part of the transition area where the two blends are approximately equal” (emphasis added) , the goal of the slots being to provide a “sharp visual demarcation” (col. 5, 4-19). It is no leap of ingenuity that if additional areas prevented a sharp line of demarcation, that these would also be removed, given a totality of the teachings of the reference, and that is at least implicitly, if not expressly, disclosed by Koschitzky. The test for implicit showing is what the combined teachings, knowledge of the ordinary skilled, and the nature of the problem to be solved would have suggested to those of ordinary skill in the art, In re Kotzab 55 USPQ 1313. Further, Applicants arguments simply reflect a difference in the degree of cutting slots and differences in semantics without achieving any structurally different outcome or unexpected results. Simply modifying a known method to achieve essentially the same outcome is merely a predictable modification within the purview of one of ordinary skill. Applicants are reminded that KSR 82 USPQ2d 1396 forecloses the argument that a specific teaching, suggestion, or motivation is required to establish a prima facie case of obviousness. KSR establishes that design incentives, market forces, predictability, use of ordinary skill and common sense, and ordinary capabilities or ingenuity of one skilled in the art articulated by the Examiner may be relied upon to support obviousness.

5. Further arguments on page 5 assume (which the Examiner believes to be incorrect) that Koschitzky cannot remove more than overlap portions, leaving “substantial portions” of each transition area whereas Applicants cite removing the entire intermediate area. The Examiner maintains Applicants’ predictable modification (if indeed it is even a modification of Koschitzky) provides no mechanical or unexpected benefits other than perhaps visual or

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aesthetic difference, and it is well established that matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, In re Seid 73 USPQ 431. Applicants state the previous Snyder Declaration is evidence as to “mechanical and functional effects and advantages”. The Examiner strenuously disagrees, referring the reader to his paragraphs 13,14,17,18 which repeatedly refer to “sharpness” of coloration and “clear lines of demarcation”, both of which are matters related to the choice of ornamentation producing no mechanical effect or advantage.

As previously stated, the preferred embodiment of Koschitzky removes a certain central portion but the bottom line is to provide a sharp line of visual demarcation; there simply is no hint of teaching away from Applicants method. The suggestion of complete removal is evident in the totality of the teachings of the prior art as discussed above.

As to In re Seid, the fact that it remains an essential part of the MPEP after 60 years (MPEP 2144.04I) attests to the fact that the courts after 60 years have not disagreed that aesthetic design changes are not patentable due to obviousness. While patents are regularly granted to shingles having design changes, they are granted because they disclose some degree of novelty or ingenuity rather than simply making obvious modifications of the known art.

Applicants repeat arguments related to the Snyder Declaration. The Examiner had previously carefully considered the Declaration of Snyder. It appears Mr. Snyder has provided a well-written and concise summary of evolvement of aesthetic developments in the shingle arts, most of which were known to the Examiner. For example, Mr. Snyder points out developments in simulating natural shingles by changing granule coloration, thickness, etc. A summary of

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patentable changes directed to ornamentation effects/ providing “faux” appearances if you will, are provided: shingles simulating wood or tile; simulating / imitating structures or thickness variations; faux copper patinas; simulating thatched roofing when thatching is absent; simulating 3-dimensionality, shake shingles, snow drift appearance; etc, etc. The Examiner has no problem in these being inventive methods for forming unexpected appearances for roofing so the Examiner has no issue with the well-written summary. In the instant case, there is no unexpected faux simulation: no clouds, snowdrifts, faux thickness variations, simulated thatching, or any other unexpected or novel visual representation, only an obvious variation of what the prior art already teaches. No unexpected or significant outcome results from the claimed method. A wider slot does nothing more than what Koschitsky requires of his method: forming sharp visual color demarcation. Thus there is little nexus between the issues regarding the rejection of the claims and the Declaration. And it is fact the prior art only teaches the 50:50 ratio zone to be a preference; it does not prevent removing more if there are other portions which visually impair the product given the repeated guidance of forming sharp visual demarcation. Mr. Snyder also opines from this summary that the instant claims are not obvious because they are not expressly taught in the prior art (#21). The reason may simply be that since the subject matter is patently obvious, it would have never been previously granted a patent for the same reasons this Examiner rejects the instant presented claims.

The Examiner is acutely aware of the level of ordinary skill in the shingle art, as well as the qualifications of Mr. Koschitzky. The Examiner contends Mr. Koschitzky did envision the removal of any offensive amount of overlap, and simply preferred the 50:50 overlap regions because they were most visible.



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Applicants have supplied some general information about supposed commercial success but have not supplied specific information regarding sales versus market and how the commercial success is derived from the advantages set forth in the specification. The meaning of the sales figures in context of total sales and other considerations (e.g. promotion/ advertising, market share, changes in business share, fluctuations in commercial need, etc) are entirely absent. A simple statement of opinion as provided in paragraph 20 is neither objective proof nor evidence, given that Mr. Snyder is/was employed by the assignee (CertainTeed) of this application. Attempting to belittle the objective information the Examiner requires in making a clear judgment of "commercial success" is not helpful. MPEP 1504.03 III states "When evidence of commercial success is submitted, **examiners must evaluate it to determine whether there is objective evidence of success, and whether the success can be attributed to the ornamental design**" (emphasis added). Clearly this requirement is on target relative to this case, and deems the arguments alleging commercial success to be inadequate and unpersuasive. The rejections of all claims are maintained.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

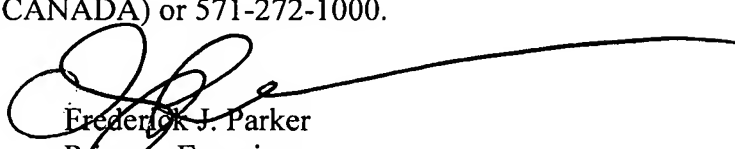
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Frederick J. Parker  
Primary Examiner  
Art Unit 1792

fjp